

## REMARKS

In the parent application, Ser. No. 10/672,033 filed September 25, 2003, a Final Office action, dated December 22, 2005, rejected claims 1-10 under 35 U.S.C. § 103(a) by Fitzgerald in view of Maleville. The present continuation application has been filed to further prosecute claims 1-10. Thus, the instant Preliminary Amendment will address the rejections from the Final Office Action.

Claims 1-10 remain in the application. Claim has been amended to include the limitation of forming a targeted device layer thickness of the epitaxial germanium layer. Support for this amendment can be found in the second paragraph of page 2, and the third paragraph on page 6, for example. No new subject matter has been added with these amendments.

### A. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

### Fitzgerald in view of Maleville-Claims 1-8

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald in view of Maleville (Office Action, page 3). The Office contends (and Applicants do not

concede) that it would have been obvious to combine Fitzgerald's bonding process with Maleville's plasma cleaning process.

However, independent claim 1 has been amended to include the limitation of forming a targeted device layer thickness by removing a predetermined amount of the epitaxial germanium layer. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Fitzgerald teaches performing CMP to reduce surface roughness, but not to form a targeted device layer thickness by removing a predetermined amount of the epitaxial germanium layer as in amended claim 1. It appears the amount of the epi layer removed in the process of Fitzgerald is independent of the targeted thickness of a particular device, but an un-targeted amount is removed to decrease surface roughness. Because neither Fitzgerald nor Maleville teach or even suggest the limitations of amended claim 1, claim 1, and claims 2-7 which depend from claim 1, are not rendered obvious by Fitzgerald in view of Maleville. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claims 1-8 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (503) 264-0944.

Respectfully submitted,

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